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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,360	06/26/2003	Yukio Tokunaga	46287	4538
20736	7590	07/24/2006	EXAMINER	
MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			JOLLEY, KIRSTEN	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,360

Applicant(s)

TOKUNAGA ET AL.

Examiner

Kirsten C. Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/230,995.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1 and 3-20 are pending.
2. It is noted that claim 2 was cancelled in the preliminary amendment of June 26, 2003. Claim 2 is included in the supplied listing of claims and should be indicated as cancelled.

#### ***Response to Arguments***

3. The 35 USC 112, 2<sup>nd</sup> paragraph rejections have been withdrawn in response to Applicant's amendments to the claims.
4. Applicant's arguments filed May 4, 2006 have been considered but are not persuasive.

Applicant has amended the claims to require that cutting is performed before printing with a printer, and Applicant argues that the recording medium cut by the cutter is after printing and there is no description about effects of cutting before printing an image. The Examiner acknowledges that Ohya et al. teaches in its exemplary embodiment that the recording medium is first printed and then cut by cutter, and thus the claims are now rejected under 35 USC 103(a) instead of 35 USC 102(e). However, Applicant's own specification states that the improved results and criticality of the instant invention lie in the step of cutting so that a longitudinal direction of the sheet is at a right angle to a flowing direction at a time of coating the ink-receptive layer – this cutting step results in the reduction of curl (or “plus curl”) during drying of the ink-receptive layer. Ohya et al. discloses this critical step of cutting such that the longitudinal direction of the sheet is at a right angle to the flowing direction, therefore the recording material of Ohya et al. must necessarily achieve similar improved resistance to curling.

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Ohya et al. performs printing prior to cutting in its Examples because the patent is concerned with high speed photographic printing, as in that performed by a commercial photograph-developing operation where hundreds or thousands of photographs are printed daily or hourly. (If cutting was performed prior to printing in this scenario, the process would be less efficient due to the need to repeatedly align each individual piece of paper in the printer.) Additionally, Ohya et al. discloses that a commercially available ink jet printer may be used in its invention, and the patent is not limited to the system described in the Examples (paragraph [0171]). It is the Examiner's position that it would have been obvious to one having ordinary skill in the art to have performed cutting prior to printing in the case of using the recording material of Ohya et al. for personal use, instead of commercial use, where printing is performed in the home or business, for example, after being bought as individual sheets in a store. One would expect similar successful results including lack of plus curl in such a scenario since it is the cutting vs. flowing direction that prevents the occurrence of plus curl, and further because Ohya et al. teaches that any conventional ink jet printer may be used with its recording material. Since Ohya et al. does not limit use of its product to high speed, commercial operations, it is the Examiner's position that one having ordinary skill in the art would have recognized the benefit of using Ohya et al.'s recording material for personal use and been motivated to use it as such in order to obtain the benefits of a recording material with improved storage stability, image quality, reduced production cost, enhanced surface strength, lack of flaws in an ink jet printer, and lack of adherence to an album protective sheet in home printing operations as well as commercial.

***Claim Rejections – 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohya et al. (US 2003/0008113).

The claims are rejected for the reasons set forth in the prior Office action. With respect to the newly added limitation requiring that cutting is performed before printing with a printer, the claims are rejected for the reasons discussed above in section 3.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj